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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,833	09/05/2003	James Andrew Walsh	019384-9176-00	8402

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EXAMINER
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MACKEY, PATRICK HEWEY

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	Application No. 10/656,833	Applicant(s) WALSH ET AL.	
	Examiner Patrick H. Mackey	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>090503</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 18 is objected to because of the following informalities: it is listed twice—on pages 10 and 18. For the purposes of this Office Action, the claim 18 found on page 18 has been deemed to be claim 38. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-14, 19-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Dutro. Dutro discloses a foldover apparatus for interfolded sheets (see col. 1, lines 1-5) that includes a conveyor (22) with a guide plate (11); a forming plow (40); and an adjustable vacuum assembly (30) with a vacuum chamber (35). Regarding claims 9-11 and 21, see M.P.E.P. § 2115.

4. Claims 22, 25, 27-29, 32, 34-36, and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Marcalus. Marcalus discloses a method of folding over a portion of at least one top sheet in an interfolded stack of sheets that includes providing a stack of interfolded sheets (11); moving the stack along a path (39); separating a portion of at least one top sheet or two top sheets (20, see col. 3, lines 15-25); moving the portion adjacent a forming plow (receiving station 33); releasing the portion into contact with the forming plow (see col. 3, line 70 – col. 4, line 2); and moving the portion along the forming plow and folding over the top portion (see Figs. 6-11).

### ***Claim Rejections - 35 USC § 103***

Art Unit: 3651

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-14, 19-21, 23-24, 26, 30-31, 33, and 37-38 are rejected under 35 U.S.C.

103(a) as being unpatentable over Marcalus in view of Dutro. Marcalus discloses all the limitations of the claims but it does not disclose separating a top portion up an inclined path using a variable strength vacuum. Marcalus is silent as to how the top portion is separated.

However, Dutro discloses a similar device that includes separating a top portion of stack of sheets up an inclined path using a variable strength vacuum for the purpose of automatically separating the top portion using a simple, rugged, compact device (see col. 1, lines 13-26). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Marcalus by separating a top portion up an inclined path using a variable strength vacuum, as disclosed by Dutro, for the purpose of automatically separating the top portion using a simple, rugged, compact device.

7. Claims 1-21, 23-24, 26, 30-31, 33, and 37-38 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Marcalus in view of Aterianus et al. Marcalus discloses all limitations of the claims but it does not disclose separating a top portion up an inclined path using a variable strength vacuum and perforated belts. Marcalus is silent as to how the top portion is separated.

However, Aterianus discloses a device that utilizes a variable strength vacuum and inclined, perforated belts (174) that separate a sheet (B) from a conveyor for the purpose of ensuring a sheet is firmly grasped while it is separated. It would have been obvious for a person of ordinary

Art Unit: 3651

skill in the art at the time of the applicant's invention to modify Marcalus by separating a top portion up an inclined path using a variable strength vacuum and perforated belts, as disclosed by Aterianus, for the purpose of ensuring a sheet is firmly grasped while it is separated.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (703) 308-0630. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick H. Mackey  
Primary Examiner  
Art Unit 3651

February 15, 2005